

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

SCOTT M. WILLIAMS

SERIAL NO.: 10/729,490

ART UNIT: 3644

FILED: DECEMBER 5, 2003

EXAMINER: TIEN Q. DINH

TITLE: PHOTSENSITIVE COCKPIT WINDSHIELD

APPEAL BRIEF

On Monday, September 11, 2006, in response to the final Office Action, dated March 10, 2006, Applicant, Appellant herein, timely appealed (with a *Petition for a Three-Month Extension of Time* for Response, pursuant to 37 C.F.R. §1.136(a), and requisite extension fee) from the final rejection of Claims 1 – 4 and 13 – 18.

Appellant now proceeds to file his *Appeal Brief* with the Appeal Brief filing fee of \$250.00 (small entity), as set forth in 37 C.F.R. §1.17(f), being remitted via EFT.

An *Amendment* is also being concurrently filed, pursuant to 37 C.F.R. §41.33(b)(1), to: (a) correct obvious typographical errors in Claim 1; and, (b) cancel independent Claims 13 – 18; the corrections to Claim 1 and the cancellation of Claims 13 – 18 will not affect the scope of any claims pending on this appeal.

I. Real-Party in Interest

(37 C.F.R. §41.37(c)(1)(i))

The real-party-in-interest is the inventor, Scott M. Williams, who is also the sole owner of the patent application and would be the sole owner of any patent issuing thereon.

II. Related Appeals and Interferences

(37 C.F.R. §41.37(c)(1)(ii))

There are no related appeals or interferences currently pending which may be related to, directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. Status of Claims

(37 C.F.R. §41.37(c)(1)(iii))

The instant patent application was filed December 5, 2003, disclosing and claiming a photosensitive cockpit windshield.

The claims were most recently amended via an *Amendment*, filed December 21, 2005, in response to a non-final Office Action, dated September 21, 2005, which resulted in the pendency of method Claims 1 – 4 and apparatus Claims 13 – 18.

On March 10, 2006, the Examiner issued a final Office Action presenting the following grounds for rejections:

A. Claims 13-18 have been rejected, pursuant to 35 U.S.C. §112, first paragraph,

as failing to comply with the enablement requirement (*i.e.*, Claims 13-18 contain subject matter which has not been described in such a way as to enable one skilled in the art to make and/or use the invention recited in the enumerated claims of the rejection.);

B. Claims 1-4 and 13-18 have rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Dockery; and,

C. Claims 1-4 and 13-18 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Wolf *et al.*, taken in view of Dockery.

No amendment after final Action (and prior to filing of the *Notice of Appeal*) were filed.

Concurrent with the filing of this *Appeal Brief*, Applicant is filing an *Amendment Pursuant to 37 C.F.R. §41.33(b)(1)* to effect cancellation of Claims 13 – 18, which will moot the grounds for final rejection issued against Claims 13 – 18, thereby leaving only Claims 1 – 4 for consideration by the Board on the instant appeal.

Therefore, the status of the claims on appeal is:

Claims allowed: None

Claims objected to: None

Claims rejected: Claims 1 – 4

Claims cancelled: Claims 5 – 18

IV. Status of Amendments

(37 C.F.R. §41.37(c)(1)(iv))

No amendments were filed subsequent to the final rejection (other than the currently-filed amendments, pursuant to 37 C.F.R. §41.33(b)(1)), presented in the Office Action, dated March 10, 2006, from which this appeal has been taken.

V. Summary of the Claimed Invention

(37 C.F.R. §41.37(c)(1)(v))

Independent Claim 1, which properly defines the invention to be considered by the Board on appeal, reads as follows:

“1. A method for a photosensitive cockpit windshield of the type suitable for use with airplanes, comprising the steps of: (a) providing a photosensitive portion of a windshield which automatically changes from a transparent state to a darker state in response to varying light conditions; and (b) adjusting the light sensitivity of said photosensitive windshield, said photosensitive portion being surrounded by an area of said windshield not being photosensitive.”

More particularly, the present invention, as most broadly claimed, provides a method for a photosensitive cockpit windshield (10), which automatically changes from a transparent state to a darker state in response to varying light conditions (*Specification* at, e.g., Page 2, lines 12 – 16; Page 19, lines 2 – 6; Page 26, line 12 – Page 27, line 4; FIGS. 2 – 3), and which further includes the step of adjusting the light sensitivity (28) of the photosensitive windshield (*Specification* at Page 19, lines 7 – 9; Page 27, last line –

Page 28, line 11; FIGS. 6, 7 and 9.) The “photosensitive portion” of a given window is surrounded by an area of the windshield that is not photosensitive (10, 30 (border region), 36 (border region)), which finds subject matter support in Applicant’s *Specification* at Page 28, lines 7 – 8; Page 29, lines 3 – 8; FIGS. 7 and 10.)

By providing that only a part of a given window has a “photosensitive portion,” while a surrounding area lacks such a photosensitive feature, in the event of a failure of the photosensitive system of the claimed invention, the windshield incorporating the present invention could not be entirely dark, or blacked-out, thereby exasperating what might already be a difficult situation into one which may also become dangerous.

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel and “fail-safe” method for providing a photosensitive region to only a portion of a window (*e.g.*, a windshield) either disclosed or suggested.

The dependent claims (*i.e.*, Claims 2 – 4) pending in the instant patent application are to stand or fall on the basis of the patentability of the independent claim (*i.e.*, Claim 1) from which such dependent claims depend.

VI. Grounds of Rejection to be Reviewed on Appeal

(37 C.F.R. §41.37(c)(1)(vi))

The final Office Action, dated March 10, 2006, provides two related prior art rejections for review on this appeal:

1. Claims 1 – 4 have been rejected as being anticipated, pursuant to 35 U.S.C. §102(b), as anticipated by, or, in the alternative, as obvious, pursuant to 35 U.S.C. §103(a), over Dockery, U.S. Patent No. 3,695,681. It is the Examiner's contention that Dockery discloses a windshield that is photosensitive with means for adjusting the sensitivity of the window to the light to adjust the opacity of the windshield. The Examiner has expressed the view that in Dockery, a portion of the windshield that is photosensitive is surrounded by an area of the windshield that does not include elements 18, 20, 22, etc., thereby either anticipating, or rendering obvious, the presently-claimed invention, as recited in Appellant's Claim 1.

2. Claims 1 – 4 have further been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Wolf *et al.*, U.S. Patent No. 4,893,908, taken in view of Dockery, on the contention that the primarily-applied reference of Wolf *et al.* teaches glass, which can be used in windshields for cars and aircrafts, that includes means for adjusting the opacity of the glass. The Examiner has acknowledged that Wolf *et al.* "is silent on the means to automatically adjust the opacity of the glass with changes in the light intensity," however, according to the Examiner, Dockery, secondarily-applied in this obviousness rejection, teaches that the means to adjust the opacity of the windshield with changes in the light intensity is well known in the art, and that combining Wolf *et al.*, taken in view of Dockery, as argued by the Examiner, would render the presently claimed invention obvious.

VII. Argument

(37 C.F.R. §41.37(c)(1)(vii))

A. Appellant's Method for a Photosensitive Windshield Is Neither Anticipated Nor Obvious over Dockery

Initially, in the final Office Action, dated March 10, 2006, the Examiner's has rejected Claims 1 – 4 solely by application of Dockery, U.S. Patent No. 3,695,681, which the Examiner has applied as either an anticipatory reference, pursuant to 35 U.S.C. §102(b), or, in the alternative, as a citation rendering obvious Appellant's claimed invention under 35 U.S.C. §103(a).

Dockery discloses a “self-defrosting windshield with automatically variable transparency,” which includes two window panes with an elastic peripheral cushion therebetween defining a compartment through which a heated, tinted liquid is circulated under thermostat control. The two window panes move relative to one another, via hydraulically-operated cylinders, which affect the transparency of the window. (Dockery, *Abstract*) While Dockery, it would seem, literally uses the term “photoresponsive device,” the windshield therein is described as “self-defrosting” and has a “thermostat control” with a heated liquid defining a region between two windows movable relative to one another. While the transparency, or visibility, of the window in Dockery might be altered as the window is defrosted, the apparatus therein is not a “photosensitive” window, but one that is sensitive to heat, or temperature – not light!

Dockery, while disclosing heat-sensitive means that might affect the transparency

of a window, fails to disclose or suggest a “photosensitive” portion, rather than a heat-sensitive region. As such, it can not be said that Dockery teaches or suggests that only a “portion” of an entire window, or windshield, includes the “photosensitive portion,” while the remainder of the window deliberately lacks the photosensitive feature.

Further, Appellant respectfully disagrees with the Examiner’s understanding of the drawing figures in Dockery, which the Examiner has argued discloses the feature of Appellant’s invention in which only a “portion,” but not the entirety, of the window (or windshield) might be photosensitive. Elements 18, 20, 22, etc., in Dockery, as best illustrated in FIG. 1, would appear to represent non-transparent window panes, or other non-transparent window borders, which are not, by definition, either a “window” or a “windshield.” Being non-transparent, and therefore not reasonably seen as being a “portion” of a “window,” or a “windshield,” that is not photosensitive, it is respectfully submitted that Dockery cannot reasonably anticipate, nor render obvious, the present invention, as claimed by Appellant.

The Examiner’s 35 U.S.C. §102(b) anticipation rejection/35 U.S.C. §103(a) obviousness rejection of Claims 1 – 4, which applies Dockery, should therefore be reversed.

*B. Appellant’s Method for a Photosensitive Windshield
Is Not Obvious over Wolf et al., Taken in View of Dockery*

Separately, in the final Office Action of March 10, 2006, the Examiner has rejected Claims 1 – 4 as being obvious, pursuant to 35 U.S.C. §103(a), over Wolf *et al.*,

U.S. Patent No. 4,893,908, taken in view of Dockery. Wolf *et al.* discloses an adjustable tint window, however, as acknowledged by the Examiner, Wolf *et al.* is silent on the means for automatically adjusting the opacity of the glass in response to changes in light intensity. The Examiner has secondarily-applied Dockery for its alleged teaching of “means to adjust the opacity of the windshield with changes in light intensity.”

As explained in connection with the initial prior art rejection which applied solely Dockery, the means for varying the transparency of the windshield (or window) disclosed therein would appear to be dependent upon heat, rather than light. Even if this was not the case – and the apparatus in Dockery were truly a “photosensitive” window – it is respectfully contended that neither Dockery nor Wolf *et al.*, considered separately or in combination with one another, teaches or suggests that only a “portion” of a window or windshield should include a photosensitive area, while another portion of the window or windshield deliberately avoids use of a photosensitive material, as claimed by Appellant.

Accordingly, the Examiner’s 35 U.S.C. §103(a) obviousness rejection of Claims 1 – 4, which applies Wolf *et al.*, taken in view of Dockery, should properly be reversed by the Board.

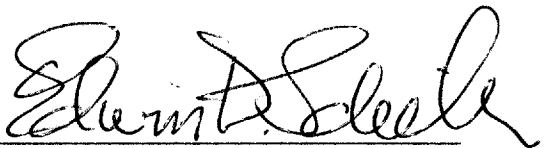
VIII. Conclusion

In light of the foregoing, Applicant respectfully submits that all claims now pending in the above-identified patent application (*i.e.*, Claims 1 – 4) recite a novel and “fail-safe” method for providing a photosensitive region to only a portion of a window (*e.g.*, a

windshield), which in the event of a failure of the photosensitive system of the claimed invention, the windshield incorporating the invention would not be entirely dark, or blacked-out, thereby exasperating what might already be a difficult situation into one which may also become dangerous, which is patentably distinguishable over the prior art. Reversal of the Examiner's final rejection, as presented in the Office Action, dated March 10, 2006, is therefore respectfully requested and earnestly solicited to be appropriate.

Respectfully submitted,

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- Enc.: 1. *Claims Appendix*, pursuant to 37 C.F.R. §41.37(c)(1)(viii);
2. *Evidence Appendix*, pursuant to 37 C.F.R. §41.37(c)(1)(ix);
3. *Related Proceedings Appendix*, pursuant to 37 C.F.R. §41.37(c)(1)(x);
4. Amendment, pursuant to 37 C.F.R. §41.33((b)(1), amending Claim 1 and canceling Claims 13 – 18; and,
5. An EFT for \$250.00 - Appeal Brief Fee (small entity), pursuant to 37 C.F.R. §1.17(f).

The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicant's Attorney (*Account No. 19-0450*) for any fees or costs pertaining to the prosecution of the above-identified patent application, but which have not otherwise been provided for.

Claims Appendix

(37 C.F.R. §41.37(c)(1)(viii))

1. A method for a photosensitive cockpit windshield of the type suitable for use with airplanes, comprising the steps of: (a) providing a photosensitive portion of a windshield which automatically changes from a transparent state to a darker state in response to varying light conditions; and (b) adjusting the light sensitivity of said photosensitive windshield, said photosensitive portion being surrounded by an area of said windshield not being photosensitive.

2. The method of Claim 1, further comprising the step of controlling a photosensitive circuit of the photosensitive portion of said windshield to enable or disable operation of the photosensitive windshield.

3. The method of Claim 2, further comprising the step of adjusting the opacity of the photosensitive portion of the windshield.

4. The method of Claim 3, further comprising the step of adjusting the response rate of the photosensitive portion of the windshield.

Claims 5 – 18 (canceled)

Evidence Appendix

(37 C.F.R. §41.37(c)(1)(ix))

None.

Related Proceedings Appendix

(37 C.F.R. §41.37(c)(1)(x))

None.